

REMARKS

Applicants have carefully reviewed the Office Action mailed on May 21, 2008. Applicants respectfully traverse (and do not concede) all objections, rejections, adverse statements, and adverse assertions made by the Examiner. With this amendment, claim 18 is amended. No new matter is added. Please cancel claims 1-17, 19-21, 78 and 81 without prejudice. Claims 18, 25, 27, 53, 55, 58-59, and 82-87 remain pending.

Claim Rejections under 35 U.S.C §103

Claims 1-4, 6-8, 10, 14, 19, 20, 25, 27, 53, 55, 58, 59, 78, and 81-87 are rejected under 35 U.S.C. §103(a) as being unpatentable over Jacobsen et al. in U.S. Patent No. 6,579,246 in view of Shiber in U.S. Patent No. 5,135,531, as evidenced by Hernandez et al. in U.S. Patent No. 5,396,212. Applicants respectfully traverse this rejection.

Without conceding the merits of the rejection, please note that claims 1-4, 6-8, 10, 14, 19, 20, 78, and 81 are now cancelled without prejudice, rendering the rejection thereof moot. Applicants reserve the right to pursue these claims or claims of a similar scope in the future.

Regarding the remaining claims, the Examiner indicated in the Response to Arguments section that “KSR v. Teleflex allows for the simple substitution of one known element for another to obtain predictable results.” We believe that the Examiner has extended the holding of KSR well beyond what the United States Supreme Court ruled. In speaking about how simple substitution generally does not produce a non-obvious invention, the Supreme Court reminded us in KSR of how for nearly 60 years that:

a ‘patent for a combination which only unites old elements with no change in their respective functions ... obviously withdrawn what is already known in the field of its monopoly and diminishes the resources available to skillful men.’

KSR Int’l Co. v. Teleflex Inc., (550 U.S. __ 2007), page 12 of the April 30, 2007 slip opinion quoting Great Atlantic and Pacific Tea Co. v. Supermarket Equipment Corp., 340 U.S. 147, 152 (1950). Based on this well established principle, substituting a screw for a nail is not likely to yield a non-obvious invention. The Supreme Court did not reverse this standard in KSR and it remains the law today.

When assessing obviousness, one must not lose track of the governing standard articulated by the Court – namely, that uniting old objects without a change in function (e.g., substituting one known element like a nail for another such as a screw) is likely to be obvious. Turning now to the instant application, the Examiner is attempting to substitute an auger shaped coring wire on an atherectomy system (which is designed to bore through an obstruction in a vessel) for a radiopaque coil (which is designed to aid in visualization of the device). This is not merely the uniting of old elements without a change in their respective functions (e.g., like substituting a nail for a screw) but rather a completely redesigned device that is created without regard to the function of the elements at all. Not only does this substitution fail to be obvious, the art strongly supports the notion that such a substitution would be non-obvious under the Supreme Court’s well-established rules.

Based on the forgoing comments, Applicants respectfully submit that the rejection of claims 25, 27, 53, 55, 58, 59, and 82-87 is flawed and should be withdrawn in due course.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobsen et al. and Shiber, as evidenced by Hernandez et al. as applied to claim 7 above, and further in view of Lui in U.S. Patent Application Publication No. 2002/0010475. Without conceding the merits of the rejection, please note that claim 13 is now cancelled without prejudice, rendering the rejection thereof moot. Applicants reserve the right to pursue this claim or claims of a similar scope in the future.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobsen et al. and Shiber, as evidenced by Hernandez et al. as applied to claim 7 above, and further in view of Levine et al. in U.S. Patent Application Publication No. 2003/0009157. Claim 18 is amended into independent form and recites, among other things, a first tubular member having a chamfer at said proximal end. The Examiner indicated that Jacobsen et al. and Shiber fail to disclose a tubular member having a chamfer at the proximal end. However, the Examiner indicated that Levine et al. discloses “a flexible flow apparatus and further disclose the tubular member having a chamfer at the proximal end”, citing paragraph 0153, and that “[i]t would be obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Jacobsen et al and Shiber to include the tube having a chamfer at

the proximal end, as per the teachings of Levine et al, since it would provide a means of securing the tube to the core and coil.” We respectfully disagree.

The cited text in Levine et al. discloses that “[t]he distal portion of the tube would be chamfered to fit snugly within a distal portion of a short coil ...”. (emphasis added). Thus, Levine et al. does not teach or suggest a first tubular member having a chamfer at said proximal end but rather teaches the distal portion of the tube would be chamfered. Because of this distinction, Applicants respectfully submit that none of the cited references, either alone or in combination, teach or suggest the claimed invention.

Furthermore, Levine et al. teaches that the distal portion of the tube is chamfered to fit snugly within a coil. Thus, the chamfered distal portion of the tube only appears to aid in the joining of the tube to the coil. The claimed first tubular member having a chamfer at said proximal end provides the claimed invention with a number of desirable characteristics and functions in more ways than just in aiding a connection. For example, paragraph [0070] discloses, among other things, that the proximal chamfer may desirably form a gradual taper at joint 140, smooth the transition in diameter from core wire 150 to tubular member 130, form a more gradual change in bending stiffness, reduce stress concentration, provide more surface area for bonding, etc. Consequently, one of ordinary skill in the art would not view Levine et al. as providing a teaching of a structure that provides the same desirable characteristics as the claimed first tubular member having a chamfer at said proximal end.

Application Serial No. 10/604,504
Amendment AF dated JULY 21, 2008
Reply to Final Office Action dated May 21, 2008


Conclusion

Reexamination and reconsideration are requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is also respectfully requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,
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By their Attorney,

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